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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/990,326	11/23/2001	Anthony Derosé	PT-1475000	2546

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EXAMINER

SILBERMANN, JOANNE

ART UNIT	PAPER NUMBER
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3611

DATE MAILED: 09/08/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

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## Office Action Summary

Application No.

09/990,326

Applicant(s)

DEROSE, ANTHONY

Examiner

Joanne Silbermann

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 16 June 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-9, 12-16, 21-29 and 31-43 is/are pending in the application.
- 4a) Of the above claim(s) 29 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-9, 12-16, 21-28 and 31-43 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 16 June 2005.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

**DETAILED ACTION**

***Election/Restrictions***

1. Claim 29 stands withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim.

***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:  
  
The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.
3. Claims 12 and 21 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
4. In claim 12 "the light scattering means" lacks antecedent basis.
5. In claim 21 lines 9-10 "the light scattering surface" is not definite, since several of these surfaces have been recited in line 6.

***Claim Rejections - 35 USC § 102***

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claims 1, 4-7, 12, 15/12, 21, 22, 27, 31, 36, 39/1, 39/12, 39/21, 39/27 and 42 are rejected under 35 U.S.C. 102(b) as being anticipated by Giuliano et al.

8. Giuliano et al. teach an ornament comprising a body panel 10 made of plastic having sides and an etched surface 10a with a design 12 (Figures 1 and 2). This design may be any non-random image (column 2 line 22) which includes designs of company logos. Opening 11 in one side of the body holds light emitting diode 1 by means of transparent material 2. A plurality of light sources may be used. The body panel may be colored and may include a mirrored surface. Giuliano et al. also disclose a switching/timer device for operating the display.
9. The display of Giuliano et al. is decorative in that it is described as "design art" (column 1 line 45) and "an art rendering" (column 2 line 21). The artwork or rendering is considered to be a symbol and may be for Christmas.
10. Giuliano et al. do not teach the specific method by which the article is made, however the method of forming the device is not germane to the issue of patentability of the device itself. Therefore, this limitation has not been given patentable weight.

***Claim Rejections - 35 USC § 103***

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

12. Claims 2, 3, 13, 15/13, 37, 38, 43/1, 43/12, 43/21, 43/27 and 43/31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Giuliano et al. in view of Ming-ho.
13. Giuliano et al. do not specifically teach a Christmas ornament, Santa Claus, crucifix, or heart, however Min-ho teaches a variety of ornaments and structures, as

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discussed in column 14 lines 37-53. It would have been obvious to a person having ordinary skill in the art to utilize any well known shape or ornament to serve the user's particular purpose. Additionally, matters relating to ornamentation only, and having no mechanical function, cannot be relied on where claims are not directed to design but are structural claims. In re SEID, 73 USPQ 431 (CCPA 1947).

14. Claims 8, 9, 34, 35, 39/8, 39/34, and 39/35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Giuliano et al. in view of Lee.

15. Giuliano et al. do not teach supporting rails in a housing, however Lee teaches housing 1 with one rail structure at the top of the sign. Lee further teaches light emitting diodes located in the rail structure. It would have been obvious to a person having ordinary skill in the art to utilize such a rail structure to support the ornament of Giuliano et al. It would have been obvious to one of ordinary skill to provide another similar rail structure at the bottom of the sign and separated to receive the display, as this would be a duplication of known parts.

16. Claim 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over Guiliano et al. in view of Dimmick.

17. Giuliano et al. do not teach the secondary light scattering elements as being shavings or bubbles, however this is well known in the art. Dimmick teaches an illuminated sign including light scattering means comprising bubbles (column 4 lines 67-68). It would have been obvious to a person having ordinary skill in the art to utilize bubbles as a light scattering means (as shown by Dimmick) to provide additional, increased illumination for the display.

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18. Claims 16/12, 23-26, 28 and 32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Giuliano et al. in view of Volland.

19. Giuliano et al. do not teach a string of ornaments, however Volland teaches string 14 of ornaments 15. The ornaments are different sizes and shapes. It would have been obvious to one of ordinary skill in the art to utilize a string of ornaments to provide a larger, more aesthetically pleasing display.

20. Claim 33 is rejected under 35 U.S.C. 103(a) as being unpatentable over Giuliano et al. in view of Day et al.

21. Giuliano et al. do not teach using the illumination in a necklace, however this is well known in the art as shown by Day et al. It would have been obvious to one of ordinary skill to utilize the illumination of Giuliano et al. in forming a necklace so as to provide an illuminated pendant, as is discussed by Day et al.

22. Claim 16/13 is rejected under 35 U.S.C. 103(a) as being unpatentable over Giuliano et al. and Ming-ho as applied to claim 13 above, and further in view of Volland.

23. It would have been obvious to one of ordinary skill to utilize a string of ornaments to provide a larger, more aesthetically pleasing display.

24. Claims 40 and 41 are rejected under 35 U.S.C. 103(a) as being unpatentable over Giuliano et al. and Lee as applied to claims 8, 34 and 35 above, and further in view of Oda et al.

25. Giuliano et al. do not teach a reflective panel, however such panels are well known in the art of signs. Oda et al. teach a sign having illumination and concave

reflector 5. It would have been obvious to one of ordinary skill to utilize such a reflector so as to provide more illumination from the light sources, as is the purpose of reflectors.

26. Claims 43/8, 43/34 and 43/35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Giuliano et al. and Lee as applied to claims 8, 34 and 35 above, and further in view of Ming-ho.

27. Giuliano et al. and Lee do not teach specific uses for the light, however Ming-ho teaches a variety of ornaments and structures, as discussed above. It would have been obvious to a person having ordinary skill in the art to utilize any well known shape or ornament to serve the user's particular purpose. Additionally, matters relating to ornamentation only, and having no mechanical function, cannot be relied on where claims are not directed to design but are structural claims. In re SEID, 73 USPQ 431 (CCPA 1947).

### ***Response to Arguments***

28. Applicant's arguments filed June 16, 2005 have been fully considered but they are not persuasive.

29. Applicant argues that the panels of Giuliano are not made by molding and therefor the reference does not teach the claimed invention. However, as discussed in the above rejection, the claimed invention is an article, not a method of making. Such method steps have been fully considered, but do not provide patentability in article claims.

30. Applicant also argues that no motivation is provided for making the combinations of references. The test for combining references is what the combination of disclosures

taken as a whole would suggest to one of ordinary skill in the art. *In re McLaughlin*, 170 USPQ 209 (CCPA 1971).

31. Specifically, regarding the Ming-ho reference, Applicant argues that Santa Claus (for example) is not specifically taught. However, Ming-ho is described as teaching a variety of ornaments. Also, as stated in the rejection, the particular shape of the ornament is considered to be an obvious matter of design choice.

32. Regarding Volland, Applicant again argues that the reference is not molded, however this was addressed previously.

33. Regarding Lee, Dimmick, Day and Oda, Applicant once again argues that the references do not show the method of making as molding, which is discussed above.

### ***Conclusion***

34. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of




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the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joanne Silbermann whose telephone number is 571-272-6653. The examiner can normally be reached on M-F 5:30 - 2:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lesley Morris can be reached on 571-272-6651. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Joanne Silbermann  
Primary Examiner  
Art Unit 3611

JS  
6 September 2005